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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,074

04/01/2004

Kim L. Desch

8895

7590

08/07/2006

Kim L. Desch  
14994 Huntington Gate Dr.  
Poway, CA 92064

EXAMINER

STERLING, AMY JO

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/816,074

Applicant(s)

DESCH, KIM L.

Examiner

Amy J. Sterling

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/1/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is the first Office Action for application number 10/816,074, Assistive Ergonomic Desktop System and Modular Components, filed on 4/1/04. Claims 1-28 are pending.

### ***Election/Restrictions***

Claims 10, 11 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/23/06.

### ***Information Disclosure Statement***

The information disclosure statement submitted on 4/1/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "magnets" (claim 12), the "suction clip(s)" (claim 15), the "lights" (claim 16), the "writing guides" (claim 17), the "suction cup, magnet, Velcro, releasable adhesive or static electric attraction" (renumbered claim 26), "back lighting, document illumination, document holding, storage, writing surface extension, clamping, cup holder, electrical power outlet,

communication portion" (renumbered claim 27),, "easel" (claim 28) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims

Art Unit: 3632

are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim 20 was never presented. Misnumbered claims 21-29 been renumbered 22-28 accordingly.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-17 and renumbered 26-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following claims contain elements which have structural features which are not adequately described by the specification in such a way so that a person of ordinary skill in the art could make or use the device:

magnets" (claim 12), the "suction clip(s)" (claim 15), the "lights" (claim 16), the "writing guides" (claim 17), the "suction cup, magnet, Velcro, releasable adhesive or static electric attraction" (renumbered claim 26), "back lighting, document illumination, document holding, storage, writing surface extension, clamping, cup holder, electrical power outlet, communication portion" (renumbered claim 27), "easel" (claim 28).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5-8 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the bottom surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites, "a functionality-enhancing module which may/may not be used for an optional document holder" and it is unclear if the "module" is intended to be a part of the claim, rendering the claim indefinite.

Claim 7 recites, the limitation "the bottom aspect" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 also recites, "for the purpose of limited frictional movement" and it is unclear what is meant by "frictional movement" and how this is limited by the bumpers.

Claim 28 recites, "the rear plane". There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites, "wherein may provide" and it is unclear as to which element the claim may be referring.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, 9, 13, 18, 20-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 6283432 to Hoose, Jr.

The patent to Hoose, Jr. discloses a portable assistive desktop device (10) having a substantially transparent and clear body (22) with open sides having a writing surface (22) extending from a monolithic base unit (42, 48) being made from a continuous sheet of plastic, the writing surface extending at an angle between 10 and 30 degrees from the base, the writing surface attached at a first end, the writing surface having a utility ledge/means for document retention (D) near the first end and one slot (26) near a second end with a document holder (46) with an attachment tabs/means for attaching expansion modules (62) sized to fit in the slot and a rear surface (44) extending between the writing surface and the base (42, 48) at a second end and a means (50, 54) for releasably attaching the body to a supporting structure which includes a high friction interface, wherein the device may provide dial functionality as both an angled writing surface and easel when positioned such that the rear place in in contact with the supporting structure.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6283432 to Hoose, Jr. as applied to claim 1 above, and in view of United States Patent No. 5967483 to Liberfarb et al.

Hoose, Jr. discloses applicant's basic inventive concept, all the elements which are shown above and including that that means for attaching are affixed to a bottom surface with the exception that it does not show that the means for releasable attaching are suction cups.

Liberfarb et al. teaches a desktop device having a means for attaching (1) the device which are suction cups (1), used in order to further secure the device to the desired surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Liberfarb et al. to have used suction cups, in order to further secure the device to the desired surface.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6283432 to Hoose, Jr. as applied to claims 1, 5 and 6 above, and in view of United States Patent No. 6098952 to Tonn.



Hoose, Jr. discloses applicant's basic inventive concept, all the elements which are shown above including teaching friction bumpers, but does not teach wherein the bumpers are specifically silicone.

Tonn teaches desktop device with bumpers (28), used to limit movement which are made of silicone (See Col. 4, lines 28), the silicone used for its resilient and frictional properties. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Tonn to have used a bumper made of silicon, in order to have a resilient and frictional bumper.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6283432 to Hoose, Jr. as applied to claim 1 above, and in view of United States Patent No. 6231023 to Morton.

Hoose, Jr. teaches applicant's basic inventive concept, all the elements which are shown, but does not teach a handle near the first end.

Morton teaches a desktop device with a writing surface (14) which has a handle (38) near a first end, the handle used to assist in moving the device to a desired location. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Morton to have included a handle in the writing surface in order to assist in movement of the device.

Art Unit: 3632

Claims 14, 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6283432 to Hoose, Jr. as applied to claim 1, 13, 20 and 25 above, and in view of United States Publication No. 2003/0168570 to Peters.

Hoose, Jr. teaches applicant's basic inventive concept, all the elements which are shown above, but does not teach a suction clip, clamping or magnets affixed to a non-writing side of the writing surface.

Peters teaches a transparent desktop device having a writing surface (90) which has clips (49A, 49B) for clamping documents behind the writing surface. Peters does not specifically show suction clips or magnets, but it would be obvious to one of ordinary skill in the art to have used any suitable means of attaching these documents to the writing surface, in order to view them through the writing surface.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6283432 to Hoose, Jr. as applied to claim 1 above, and in view of United States Patent No. 5829787 to Newhouse, Jr. and in view of United States Publication No. 2003/0168570 to Peters.

Hoose, Jr. teaches applicant's basic inventive concept, all the elements which are shown above, but does not teach a light and a writing guide on the desktop device.

Newhouse, Jr. teaches a light (16) and a writing guide (6) for a desktop device, used to illuminate and to aid the user in marking the desired item. Therefore these concepts are also obvious to have been included in the device from the teachings of

Art Unit: 3632

Newhouse, Jr. Positioning of these items behind the transparent item to keep them out of the way is clearly taught by Peters.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following documents show various desktop devices

6729653 to Greer; 6439612 to Greer; 5884889 to Crosby

5651525 to Yang; 5474333 to Schrader; 4893775 to Long

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 571-272-6823. The examiner can normally be reached (Mon-Fri 8am-5:00pm). The fax machine number for the Technology center is 571-273-8300 (formal amendments), informal amendments or communications 571-273-6823. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 571-272-3600.



Amy J. Sterling  
AU3632 Primary Examiner  
7/27/06